

PATENT  
Docket No. J-2961A

IN THE UNITED STATES PATENT  
AND TRADEMARK OFFICE

Applicant(s): Ackerman et al.

Serial No.: 10/075,020

Filed: February 12, 2002

For: Processing Substrate, and/or  
Support Surface

Group Art Unit: 1772

Examiner: unknown

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March 10, 2003

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FOURTH SUPPLEMENTAL  
INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

The patent listed on the enclosed PTO Form-1449 is called to the attention of the examiner pursuant to 37 CFR §§ 1.56, 1.97, and 1.98. In accordance with 37 CFR §1.98(d), a copy of the document listed on the enclosed PTO Form-1449 is not provided because it was previously submitted to the Patent Office in the following prior application that applicants rely upon for an earlier filing date under 35 U.S.C. §120:

Applicants: LeBeouf et al.

Serial No.: 09/677,633

Filed: October 7, 2000

Title: PROCESSING SUBSTRATE AND/OR SUPPORT SURFACE

Status: Pending

Applicants further wish to call to the attention of the Examiner certain research activities that the assignee of the above-identified application (hereinafter the "assignee") conducted more than one year prior to the filing date of the present invention. The activities discussed below were undertaken by employees of the present assignee either alone or with the assistance of a marketing research agency. The research activities involved the showing of concept boards and prototypes (attached hereto as Exhibits 1 – 14) to third parties on a confidential basis.

In summary, the product concepts and test fall into one or both of the following areas:

- 1) the test was of a *bona fide* experimental nature and, as such, falls under the experimental use exception to 35 USC § 102(b) and/or 2) the concept shown did not disclose every element of the claimed invention and thus cannot be considered an anticipatory § 102(b) prior use.

#### First Set of Experimental Tests

In January of 1985, Dow Brands (subsequently purchased by the assignee) requested the services of a marketing agency known as Burke Marketing Research of Cincinnati, Ohio, to conduct a study of a design for a sheet product referred to as "Butcher Block Disposable Cutting Sheets." The study was conducted in four cities involving 240 participants and, upon information and belief, all participants in the study signed confidentiality agreements and none of the products represented on the concept board were offered for sale. The purpose of the study was to determine how well the design performed against the participants' expectations based upon only the information on copies of a concept board (a copy is attached hereto as Exhibit 1).

The concept contemplated on the board was a strong plastic sheet 18" x 12" in size with a non-slide backing. There was no disclosure of a multi-layer sheet or a sheet with any absorbent qualities.

A member of Dow Brands' marketing research department drafted a summary of the study in February of 1991, several years after the study was requested (the summary is

attached hereto as Exhibit 15). The summary stated that applicant should reconsider and reposition the sheet product to better address the participants' concerns.

Second Set of Experimental Tests

In April of 1985, Dow Brands requested the services of a marketing agency known as The Vanderveer Group of Lansdale, Pennsylvania, to conduct a study of "Cut 'n' Toss Disposable Cutting Boards." The study was conducted in Indianapolis, Indiana on May 7<sup>th</sup> and 8<sup>th</sup> 1985, and involved three focus groups of participants. Upon information and belief, all participants in the study signed confidentiality agreements and none of the products represented on the concept boards or shown in physical form to the participants were offered for sale. The purpose of the study was to provide guidance in determining which design should be considered for further evaluation. The participants were questioned about several variables, such as size, thickness, color, shape, etc. of the sheets.

The study exposed one focus group of participants to clear plastic and white paperboard prototypes of the cutting sheet and allowed some participants an opportunity to use the prototypes in a controlled setting. While no physical samples remain in existence, a description of the products tested can be seen on page 4 of Exhibit 16 attached hereto. The other two participant focus groups were only exposed to a concept board describing the "Cut 'n' Toss Disposable cutting board" (a copy of the concept board is attached hereto as Exhibit 2).

In the test setting the clear plastic and white paperboard prototypes of the concept described on the concept board Exhibit 2 failed to perform as expected and proved to be easy to cut through by the participants. A summary report was created in May of 1985 (a copy is attached hereto as Exhibit 16) recommending development of a much stronger alternative.

Third and Fourth Sets of Experimental Tests

In March of 1997 and September of 1998, third and fourth sets of experimental tests were ordered from AC Nielsen BASES of Cincinnati, Ohio by the assignee. Both tests involved 155 participants in various locations and, upon information and belief, all

participants signed confidentiality agreements. The concept board shown to the participants in the third test described a surface protector made of a sturdy paper fiber that is capable of stopping juices from meat and other food from reaching a underlying surface, however the concept board made no mention of how this was to be accomplished (copy of concept board attached hereto as Exhibit 3). The concept contemplated was in a roll form that could be torn off the roll in various sizes. The concept also contemplated the inclusion of a light adhesive on the back side to hold the product in place on a counter top.

The concept board shown to the participants in the fourth test described a "disposable cutting sheet" 12" x 15" in size and packaged in sets of 10 sheets (copy of concept board attached hereto as Exhibit 4). The concept further comprehended a highly absorbent material to trap liquid coupled with a cut proof bottom portion to protect a counter.

Upon information and belief, in both the third and fourth sets of tests the participants were monetarily compensated for their time and no products were offered for sale to the participants. At the conclusion of the tests summary reports were prepared and product development continued in response to the participants' input (a copy of each summary is attached hereto as Exhibit 17 for the third set of tests and Exhibit 18 for the fourth set of tests).

#### Fifth Set of Experimental Tests

In November of 1998, applicant requested the services of a marketing agency known as Opinion Search of Detroit, Michigan, to conduct a study of prototypes of a disposable cutting sheet (copies of photographs of the prototypes are attached hereto as Exhibits 5 – 10). The study was conducted in Detroit, Michigan, and involved four groups totaling 18 participants. Upon information and belief, all participants in the study signed confidentiality agreements. The purpose of the study was to determine how well the prototypes performed against participants' expectations in an actual use setting and to facilitate the development of an improved product based upon reactions to the prototypes.

The study exposed the participants to the prototypes shown in Exhibits 5 – 10 in the form of small cutting sheets. The concepts were dual layer sheets having an absorbent top

layer and a strong cut resistant plastic bottom layer. All of the prototypes had a similar clear plastic bottom layer. The concept shown in Exhibit 5 had a top layer of a thin pocketed absorption sheet. The concept shown in Exhibit 6 had a top layer of layered loosely packed fibers while the concept shown in Exhibit 7 had a top layer of a thin textured absorption sheet. The concept shown in Exhibit 8 had top layer of layered loosely packed fibers but packed more densely than the fibers of the concept of Exhibit 6. The concept shown in Exhibit 9 had a top layer of loosely packed fibers with a smooth top presented to the user as a cutting surface. The concept shown in Exhibit 10 had a top layer of a thin textured absorption sheet thicker than the top layer of the concept identified as Exhibit 7. The participants were allowed to cut tomatoes on the sheets and were asked for their opinions on the prototypes. Residue in the pictures of the prototypes is a result of the cutting of the tomatoes. The participants were not allowed to remove any of the prototypes from the test site. Furthermore and upon information and belief, the participants did not pay for any of the samples used and the participants were monetarily compensated for their time while doing the experimentation.

Based upon feedback from the participants the assignee learned that: 1) the absorbent layer sometimes attached to the food; 2) the material bottom must be flexible so it can be disposed of without taking up a lot of room; and 3) the sheet should not move-slide when being used (a copy of summary report attached hereto as Exhibit 19).

#### Sixth Set of Experimental Tests

In June of 1999, applicant requested the services of a marketing agency known as Interactive Solutions of Grand Rapids, Michigan, to conduct a study of prototypes of disposable cutting sheets (copies of photographs of prototypes attached hereto as Exhibits 11 - 13) compared to a paperboard cutting sheet similar to products known on the market (a copy of a photograph of cutting sheet is attached hereto as Exhibit 14). The study was conducted in Grand Rapids, Michigan and involved 120 participants. Upon information and belief all participants in the study signed confidentiality agreements. The purpose of the study was to determine how well the prototypes performed against participants' expectations

in actual home use setting and to allow the development of an improved device based upon reactions to the prototypes.

Each participant was given a number of samples the paperboard product shown in Exhibit 14 to use at home for two weeks. Each participant was also given a number of samples of one of the prototypes shown in Exhibits 11 – 13 to use for a second two-week period. The participants were asked to track each use of the product or prototype and make comments regarding the use.

The concept shown in Exhibit 11 was a non-absorbent film sheet made of a white copolymer with a no slip backing. The concept shown in Exhibit 12 was a two layer sheet with an absorbent top layer and a cut resistant plastic film bottom layer. The concept shown in Exhibit 13 was a three layer design with a plastic scrim as a top layer, a cut resistant plastic film bottom layer and an absorbent layer therebetween. The cutting board shown in Exhibit 14 is a paperboard product similar to products already in the marketplace.

At the end of the test period Interactive Solutions interviewed each participant and collected data sheets that had been filed out by the participants. Upon information and belief, and similar to the fifth set of tests described above, the participants did not pay for any of the samples used and the participants were monetarily compensated for their participation in the experiment. Furthermore, participants were required to return any unused prototypes (a copy of the test procedure attached hereto as Exhibit 20). Also upon on information and belief, the participants were instructed to dispose of the used samples as normal kitchen garbage due to the health concern of keeping used samples that had been utilized for cutting uncooked meats.

An invention can be rendered unpatentable under 35 USC § 102(b) when there has been a public use of the invention more than one year prior to the filing of a patent application directed thereto. *Atlantic Thermoplastics Co., Inc. v. Faytex Corporation*, 970 F.2d 834, 836 (Fed. Cir. 1992). The use must involve a device that embodies or makes obvious each and every element of the claimed invention, and if the device does not § 102(b) cannot be utilized.

*Id.* “Public use” of a claimed invention under §102(b) has been defined as any use of the invention by a person other than the inventor who is under no limitation, restriction, or

obligation of secrecy to the inventor. *In re Smith and McLaughlin*, 714 F.2d 1127 (Fed. Cir. 1983) citing, *Egbert v. Lipmann*, 104 U.S. 333, 336 (1881).

Experimental use is an exception to the 35 U.S.C. §102(b) "public use" bar. As stated by the U.S. Supreme Court, "The use of an invention by the inventor himself, or any other person under his direction, by way of experiment, and in order to bring the invention to perfection has never been regarded as such a [public] use." *City of Elizabeth v. American Nicholson Pavement Co.*, 97 U.S. 126, 134 (1878). There may be an experimental use following a reduction to practice as long as the experiments are part of an attempt to further refine a device. *Poole v. Mossinghoff*, 214 U.S.P.Q. 506, 510 (D.D.C. 1982).

Experimental use applies where the totality of circumstances indicates that the dominant purpose of a disclosure was to determine efficacy of a device (e.g., how well the device works) and not to gauge consumer demand. *In re James A. Smith*, 714 F.2d 1127 (Fed. Cir. 1983). In determining the dominant purpose, a court may assess a number of factors including: the amount of control the inventor exercised over the testing; the length of the test period; whether any payment was made; whether there was a secrecy obligation; whether progress records were kept; whether someone other than the inventor conducted the experiments; and the degree of commercial exploitation during the tests in relation to the purpose of the experimentation. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1380 (Fed Cir. 1998) (Bryson, J., dissenting in part); *Baker Oil Tools, Inc. v. Geo Vann, Inc.*, 828 F.2d 1558, 1564 (Fed. Cir. 1987).

Applying the facts to the law, none of the six sets of experimental tests conducted by the assignee qualifies as a § 102(b) prior public use. With respect to the first set of experimental tests, the testing conducted with the concept board shown in Exhibit 1 was of an experimental nature. The circumstances of the test were that all participants signed confidentiality agreements, progress records were kept, the length of time was short and was only of a period necessary to undertake the test, and the assignee's agents kept control over the concept boards. Furthermore, the degree of commercial exploitation was negligible since none of the products represented on the concept boards were offered for sale. Thus, the factors to be examined weigh in favor of a finding of experimental use.

However, even if the test were not of an experimental nature, the concept board did not disclose enough information to be anticipatory under § 102(b). The concept board did not disclose any method by which the surface was protected nor did the concept include any reference to any liquid absorbent portion or any liquid impervious portion. Also, the participants never saw or utilized a device, they were simply asked about a concept board. Therefore, the concept board shown in Exhibit 1 did not disclose the claimed invention.

In the second set of experimental tests the testing conducted with prototypes of the concept described on the concept board shown in Exhibit 2 was also of an experimental nature. The circumstances of the test were similar to the first set in that all participants signed confidentiality agreements, progress records were kept, the length of time was short and was only of a period necessary to undertake the test, the assignee's agents kept control over the concepts, and the degree of commercial exploitation was negligible since none of the products represented on the concept boards were offered for sale. Thus, as in the first set of tests the factors weigh in favor of a finding of experimental use.

However, even if the test were not of an experimental nature, the concept board shown in Exhibit 2 and prototypes used did not disclose enough information to be anticipatory under § 102(b). The concept board and prototypes did not disclose any reference to any liquid absorbent portion or any liquid impervious portion. Therefore, the concept board shown in Exhibit 2 and prototypes did not disclose the claimed invention.

The third and fourth sets of experimental tests also fall into the §102(b) experimental use exception. The circumstances of the tests were that all participants signed confidentiality agreements, progress records were kept, the length of time was short and was only of a period necessary to undertake the test and the assignee's agents kept control over the concepts. Also, none of the products described in either test were offered for sale, so the amount of commercial exploitation was negligible; rather the participants were paid for their participation in the sets of tests. As a result both the third and fourth sets of tests should fall in the experimental use exception to § 102(b).

Even if the tests were not of an experimental nature the concept boards of the third and fourth sets of experimental tests did not disclose enough information to be anticipatory

under § 102(b). The concept board shown in Exhibit 3 did not disclose any liquid absorbent portion. The concept board shown in Exhibit 4 did not disclose any liquid impervious portion. Also, the participants never saw or utilized a device in either the third or fourth set of tests, they were simply asked about a concept board. Therefore, the concept boards shown in Exhibits 3 and 4 did not disclose the claimed invention.

In the fifth set of experimental tests prototypes shown in Exhibits 5 – 10 were tested by the participants to help determine if the prototypes worked in actual use in a testing situation. During the testing all activity was controlled by the assignee's agents, control of the prototypes was managed by the assignee's agents, progress records were kept, all participants signed confidentiality agreements, and the length of time was short and was only of a period necessary to undertake the test. In terms of commercial exploitation, the participants did not purchase the prototypes they utilized and they were not offered such an opportunity; rather the participants were paid for their time as in the third and fourth test. Thus, in examining the fifth set of experimental tests, the factors to be examined weigh in favor of experimental use.

In the sixth set of experimental tests prototypes shown in Exhibits 11 – 14 were tested by the participants to help determine if the prototypes worked in actual use in a home setting. During the testing all activity was recorded by the participants on sheets provided by the assignee's agents, at the end of the test the participant's were required to send any unused samples back to the assignee's agents and were questioned about their use of the prototypes, all participants signed confidentiality agreements, and the length of time was short and was only of a period necessary to undertake the test. The participants were monetarily compensated for their participation and were given the samples to be used free of charge. Thus, in examining the sixth set of experimental tests, the factors to be examined weighs in favor of experimental use.

Based on the foregoing, the showing of concept boards and prototypes shown in Exhibits 1 – 14 do not preclude patentability of the claimed invention.

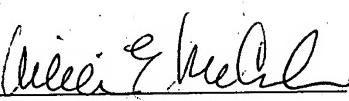
This information disclosure statement is being filed, to the best of the undersigned's knowledge, before the mailing date of a first Office action. In accordance with 37 CFR §1.97(b), no certification or fee is required.

An early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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By:   
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